

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 5, 8, 9, 11, 12, 14 and 59 are pending in the present application. Claim 1
✓ has been amended, Claims 6, 7, 10, 13 and 15-58 have been canceled and Claim 59 has been
✓ added by the present amendment.

In the outstanding Office Action, Claims 1 and 5-16 were rejected under 35 U.S.C. § 112, first paragraph; Claims 1, 5-8, 10 and 15 were rejected under 35 U.S.C. § 102(b) as anticipated by JP11-126387 (herein JP '387); Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Yoshinari et al.; Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Kikuchi et al.; Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Applicants' Figure 3; Claim 16 was rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Maro et al.; Claims 17, 21-25 and 30 were rejected under 35 U.S.C. § 102(b) as anticipated by JP '387; Claim 25 was rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Yoshinari et al.; Claims 27 and 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Kikuchi et al.; Claim 29 was rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Applicants' Figure 3; Claim 31 was rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Maro et al.; Claims 32, 36-39, 41 and 44 were rejected under 35 U.S.C. § 102(e) as anticipated by Maro et al.; Claims 34 and 35 were rejected under 35 U.S.C. § 102(e) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Maro et al.; Claim 40 was rejected under 35 U.S.C. § 103(a) as unpatentable over Maro et al. in view of Yoshinari et al. and JP '387; Claims 42 and 43 were rejected under 35 U.S.C. § 103(a) as unpatentable over Maro et al. and Kikuchi et al.; Claims 45-50, 52 and 56-58

were rejected under 35 U.S.C. § 102(e) as anticipated by Maro et al.; Claim 51 was rejected under 35 U.S.C. § 103(a) as unpatentable over Maro et al. in view of Yoshinari et al. and JP '387; and Claims 53 and 54 were rejected under 35 U.S.C. § 103(a) as unpatentable over Maro et al. and Kikuchi et al.

Claims 1 and 5-16 were rejected under 35 U.S.C. § 112, first paragraph. That rejection is respectfully traversed.

Applicants respectfully submit the specification at page 19, lines 13-18, discloses that a light is focused from a side at which a heat radiating layer 66 is formed and amended independent Claim 1 positively recites that feature. Accordingly, it is respectfully requested this rejection be withdrawn. ✓ why not prejudicial?

Claims 1, 5-8, 10 and 15 were rejected under 35 U.S.C. § 102(b) as anticipated by JP '387. That rejection is respectfully traversed.

The outstanding Office Action states that features recited in a wherein clause of a claim are interpreted as "intended use" and no patentable weight is given to those features.¹ In view of this indication, independent Claim 1 has been amended to positively recite the features of the wherein clause without adding any new matter, and Claims 6, 7, 10, 13 and 15-58 have been canceled without prejudice. ✓

Accordingly, it is respectfully submitted the remarks of the previously filed amendment patentably distinguish amended independent Claim 1 and each of the claims depending therefrom over the applied art because none of the applied art teaches or suggests that a recording layer is exposed to light via a side at which a transparent heat radiating layer is positioned to thereby perform at least one of recording and reproducing information, as required in amended independent Claim 1. ✓
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¹ Outstanding Office Action, page 3, first paragraph.

Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Yoshinari et al. That rejection is respectfully traversed.

As already discussed in the previously filed amendment, Yoshinari et al. do not overcome the deficiencies of JP '387 and Claim 9 depends directly on independent Claim 1, which is believed to be allowable. Accordingly, it is respectfully submitted dependent Claim 9 is also allowable.

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Kikuchi et al. That rejection is respectfully traversed.

As already discussed in the previously filed amendment, Kikuchi et al. do not overcome the deficiencies of JP '387 and Claims 11 and 12 depend directly on independent Claim 1, which is believed to be allowable. Accordingly, it is respectfully submitted dependent Claims 11 and 12 are also allowable.

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over JP '387 and Applicants' Figure 3. That rejection is respectfully traversed.

As already discussed in the previously filed amendment, Applicants' Figure 3 does not overcome the deficiencies of JP '387 and Claim 14 depends directly on independent Claim 1, which is believed to be allowable. In addition, Claim 13 has been canceled. Accordingly, it is respectfully submitted dependent Claim 14 is also allowable.

Because Claims 15-58 have been canceled, it is respectfully submitted the remaining rejections on the merits are moot.

New independent Claim 59 has been added to set forth the invention in a varying scope, and Applicants submit the new claim is supported by the originally filed specification. In particular, new independent Claim 59 is similar to independent Claim 1. It is believed no new matter has been added.

Independent Claim 59 is directed to an optical recording medium including a reflecting layer that includes metal or semimetal, a second protective layer, a recording layer and a first protective layer sequentially formed on a substrate. The recording layer is exposed to light via a side at which the first protective layer is positioned to perform at least one of a recording and reproducing information. The optical recording medium also includes a light transparent heat radiating layer formed on the first protective layer so as to disperse heat from the recording layer. In a non-limiting example, Figure 6 shows the substrate 61, the reflective layer 62, the second protective layer 63, the recording layer 64, the first protective layer 65 and the light transparent heat radiating layer 66.

The heat radiating layer 66 is formed on the first protective layer 65 to radiate a heat produced during an illumination of the optical recording medium. When only the first protective layer is formed on the recording layer, a local light absorption easily occurs at the surface of the optical medium. If ablation occurs due to a laser light at a time of recording or reproducing, the optical medium will be damaged and a lens will be contaminated by a deposition of the optical medium material on the lens surface, as disclosed in the specification at page 8, lines 5-11. Therefore, the heat radiating layer is formed on the first protective layer such that the recording layer is exposed to light via a side at which the first protective layer is positioned.

JP '387 shows in Figure 11 a substrate 12, a heat radiating layer 131, a recording layer 132 and a protective layer 133. The heat radiating layer 131 is formed directly on the substrate 12. Therefore, since the recording layer touches the heat radiating layer, the heat produced in the recording layer by the irradiation of a laser beam gets across the heat radiating layer promptly. Accordingly, it is respectfully submitted new independent Claim 59 patentably distinguishes over JP '387.

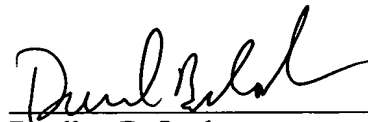
Consequently, in light of the above discussion and in view of the present amendment,
the present application is believed to be in condition for allowance and an early and favorable
action to that effect is respectfully requested. ✓

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)
BDL/DAB/RFF/rac



Bradley D. Lytle
Attorney of Record
Registration No. 40,073
David A. Bilodeau
Registration No. 42,325

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